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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,803	07/14/2003	Linda Najdek	98.22US-CON	5789

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EXAMINER
WEBMAN, EDWARD J

ART UNIT	PAPER NUMBER
1616	

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08/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/618,803	NAJDEK ET AL.	
	Examiner	Art Unit	
	Edward J. Webman	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) *23 and 24* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,649,174. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant independent claims encompass the patent claim regarding the film forming agent and ratio.

Applicanta stipulate that the rejection remains in effect until such time as they amend or file a TD.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1,2, 4-9, 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Touzan et al in view of Shah et al. Claim 9 is included here; it was inadvertently admitted in the first action on the merits.

Touzan et al teach a two phase composition for cleansing containing a demixing agent (title, abstract). An aqueous and separate oily phase in a ratio of 30:70-60:40 is disclosed (abstract). Isohexadecane, liquid paraffins, and silicone oils including cyclopentadimethylsiloxane are disclosed (column 4 lines 1-20). Colorants are specified (column 4 line 25).

Shah et al teach a polyvinylpyrrolidone/vinyl acetate copolymer at 1-5% to maintain pigments in suspension (column 4 lines 37-57). Applicants disclose this polymer on page 2 line 33.

It would have been obvious to one of ordinary skill to add a polyvinylpyrrolidone/vinyl acetate copolymer to the composition of Touzan et al for the beneficial effect of maintaining colorants in suspension in view of Shah et al.

Applicants argue that the demixer in Touzan et al is not a film-former, however, the polymer in Shah et al is such, according to applicants. Applicants argue that Touzan et al disclose only 0.05% colorant whereas Shah et al teach much larger amounts of pigment. However, Touzan et al is not limited to the disclosed amount.

Thus, if one of ordinary skill wished to increase the amount of pigment in the Touzan et al composition, Shah et al teaches the addition of polyvinylprrolidone/vinyl acetate copolymer to maintain such larger amounts of colorant in suspension. Applicants argue that PVP is known as a film former and suspension stabilizer, teaching away from a role as a demixer, however, the polymer being added here is polyvinylpyrrolidone/vinyl acetate. Even if the latter polymer is known as a film former and suspension stabilizer, Shah et al teaches its use as a suspension stabilizer for colorants. The motivation to combine need not be applicants'. Applicants argue that one of ordinary skill would be unlikely to add another ingredient to an emulsion because of the difficulty in creating a stable emulsion. However, Touzan et al do not teach such in view of the presence of a demixer. Applicants' proposition that the demixing function of Touzan et al will be compromised by addition of the Shah et al polymer, a stabilizer, is mere speculation. Applicants further argue that Touzan et al concerns an oil and water composition, whereas Shah et al concerns two miscible aqueous phases. That is, they are not analogous. Applicants further argue that, therefore, one of ordinary skill would not have a reasonable expectation of success. However, Shah et al is used only for its disclosure of the use of the polymer to maintain colorants suspended, at least in the aqueous phase. Applicants lastly argue that Touzan et al teaches away from polyvinylpyrrolidone/vinyl acetate in the oil phase, claimed in claims 21-22. However, these claims are not (and were not) under rejection here.

Claims 1, 2, 4-9, 11-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagy et al in view of Grollier et al. Claim 9 is included here; it was inadvertently admitted in the first action on the merits. Claim 10 should not have been included in that action; it has been removed here.

Nagy et al teach a makeup removing composition comprising two phases and a demixing agent (abstract). A 30:70-70:30 ratio of oil to aqueous phase is disclosed (column 3 lines 12-14). Mixtures of cyclic silicones, dimethicone and a volatile C16 paraffin are specified (column 4 lines 33-53).

Grollier et al teach two phase compositions comprising a cationic polymer for skin conditioning (abstract). Vinyl pyrrolidone–acrylamide copolymers are specified at 0.2-50% (column 8 lines 1-26, column 9 lines 20–24). Dimethylaminoethylmethacrylate is disclosed (column 8 line 59). Applicants disclose PVP/dimethylamino ethyl-methacrylate on page 2 line 32.

It would have been obvious to one of ordinary skill to add a vinyl pyrrolidone-acrylamide copolymer to the composition of Nagy et al to achieve the beneficial effect of a skin conditioner in view of Grollier et al.

Applicants argue that the suspension of cationic polymer in alcohol is known to be irritating to the eyes (no citation). However, Grollier et al do not teach an alcoholic phase. Applicants note that Nagy et al teach against incorporating a demixing agent into an oily phase, citing column 3 lines 4-5. However, Nagy et al merely prefer the aqueous phase, which is not a teaching away. Applicants argument regarding the

interference of a cationic polymer surfactant with a demixing agent is mere speculation. Applicants argue that neither Nagy et al nor Grollier et al teach the non-cationic film former of claims 8-9, However, as noted above, Grollier et al teach a polymer disclosed by applicants in their specification.

No claims allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward J. Webman whose telephone number is 571-272-0633. The examiner can normally be reached on M-F from 8 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Richter, can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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PRIMARY EXAMINER
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